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In re Application of
BUTORA, et al.
U.S. Application No.: 10/509,856
PCT No.: PCT/US04/11463
Int. Filing Date: 14 April 2004
Priority Date: 17 April 2003
Attorney Docket No.: 21240YPI
For: HETEROCYCLIC CYCLOPENTYL
TETRAHYDROISOQUINOLINE AND TETRA-
HYDROPYRIDOPYRIDINE MODULATORS
OF CHEMOKINE RECEPTOR ACTIVITY

DECISION ON PETITION

UNDER 37 CFR 1.182

This decision is issued in response to applicants' "Petition Under 37 CFR § 1.182 To Create New Application Under 35 U.S.C. § 111(a)" filed 04 January 2006.

BACKGROUND

On 14 April 2004, applicants filed international application PCT/US04/11463, which claimed a priority date of 17 April 2003 and designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 17 October 2005.

On 15 October 2004, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a Preliminary Amendment. These materials were assigned U.S. application number 10/509856. The application was created as a national stage of PCT/US04/11463 filed under 35 U.S.C. 371.

Although the amendment filed 15 October 2004 did not expressly state that it included new subject matter, the present petition states that the amended specification filed by applicants includes additional matter that was not disclosed in the international application.

On 04 January 2006, applicants filed the "Petition Under 37 CFR § 1.182 To Create New Application Under 35 U.S.C. § 111(a)" considered herein. The petition requests that the present application be treated as a filing under 35 U.S.C. 111(a) so as to provide the added subject matter

disclosed in the 15 October 2004 filing with a filing date of 15 October 2004.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states the following:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

Applicants' original Transmittal Letter, filed 15 October 2004, specifically identified the accompanying submission as a submission to enter the national stage under 35 U.S.C. 371. No contradictory instructions were submitted. Accordingly, application 10/509,856 was appropriately created as a national stage of PCT/US04/11463 filed under 35 U.S.C. 371.

However, as noted above, the present petition states that the application (i.e., preliminary amendment) filed with the 15 October 2004 submission included additional subject matter not supported by the original disclosure of the international application. Subject matter beyond that disclosed in the international application cannot be added to a national stage application. See 35 U.S.C. 132(a); PCT Article 41(2).

In light of the above, applicants have submitted a petition under 37 CFR 1.182 to have the submission filed 15 October 2004 treated as an application filed under 35 U.S.C. 111(a). Petitioner states that it was applicants' intention to file the 15 October 2004 submission as a continuation-in-part application of the international application, rather than as a national stage submission; that such error was inadvertent; and that the requested relief is necessary to preserve the filing date of the newly added subject matter. The petition included the required petition fee and authorizes a charge to Deposit Account No. 13-2755 for any required fees.

The petition is granted as follows. The "preliminary amendment," which includes a specification and claims, filed 15 October 2004 will be treated as a separate U.S. application filed under 35 U.S.C. 111(a). This application has been assigned U.S. application number 10/260,008 and is accorded a filing date of 15 October 2004.

Applicants are advised to consider the requirements under 37 CFR 1.78 for claiming

benefit of the prior filed international and provisional applications, should the benefit of such applications be desired.

Application number 10/509,856 will continue to be processed as a national stage application under 35 U.S.C. 371.

Any period of adjustment to the term of the patent under 35 U.S.C. 154(b)(May 29,2000) in application number 10/260,008 may be reduced by the period of time beginning on the filing date accorded under 35 U.S.C. 111(a) and ending on the mailing date of this decision.

CONCLUSION

Applicants' petition under 37 CFR 1.182 is **GRANTED** to the extent that the substitute specification filed 15 October 2004 with the national stage papers will be removed from the application file of 10/509,856 and will be treated as a separate U.S. application filed under 35 U.S.C. 111(a). This separate application has been assigned U.S. application number 10/260,008 and is accorded a filing date of 15 October 2004.

Application number 10/509,856 will continue to be processed as a national stage application under 35 U.S.C. 371. A copy of this decision will be placed in application number 10/260,008.

Deposit Account No. 13-2755 will be charged the required filing fee for application number 10/260,008.

Application number 10/260,008 is being referred to the Office Of Initial Patent Examination for processing as an application filed under 35 U.S.C. 111(a) having a filing date of 15 October 2004.



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